

REMARKS

At the time of the First Office Action dated March 21, 2008, claims 1-18 were pending and rejected in this application.

Applicants have cancelled claims 4-13 and 17-18 to remove these claims from further consideration in this application. Applicants are not conceding in this application that those claims are not patentable over the prior art cited by the Examiner, as the present claim cancellations are only for facilitating expeditious prosecution of the present application. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

On pages 2 and 3 of the First Office Action, the Examiner objected to the drawings. This objection is respectfully traversed. The re-sizing step of claim 1 is illustrated by step 240 in Fig. 2. The vary delays step of claim 2 is illustrated by step 210 of Fig. 2. Regarding the "machine readable storage," this is not a "feature" of the claimed invention. Instead, this phraseology is found in the preamble of independent claim 14 and describes the type of subject matter being claimed (i.e., a product).

On page 3 of the First Office Action, the Examiner objected to certain language in claims 1 and 14. The Examiner's objection appears to be a matter of personal preference. Since Applicants are unclear as to any statutory basis for the objection, Applicants decline to amend the claim in the manner suggested by the Examiner.

CLAIMS 6-13 ARE REJECTED UNDER 35 U.S.C. § 101

On page 4 of the First Office Action, the Examiner asserted that the claimed invention, as recited in claims 6-13, is directed to non-statutory subject matter. Although the Examiner's rejection is moot based upon claims 6-13 being cancelled, Applicants respectively traverse the Examiner's rejection.

At the outset, Applicants note that the Examiner has improperly framed the question regarding statutory subject matter. The question to be answered is whether the claims are directed to statutory subject matter and not whether the claims could be directed to non-statutory subject matter. The Federal Circuit has held that claims can be directed to "so-called" abstract ideas (e.g., algorithms) so long as the claimed invention, as a whole, produces a useful, concrete, and tangible result. Therefore, even if the claims could cover non-statutory subject matter, the claimed invention, as a whole, could still meet the requirements of 35 U.S.C. § 101. The Examiner, however, has not explained why the claimed invention, as a whole, does not produce a useful, concrete, and tangible result. Therefore, the Examiner has failed to establish a prima facie rejection under 35 U.S.C. § 101.

**CLAIMS 1-9, 11-12, AND 14-18 ARE REJECTED UNDER 35 U.S.C. § 103 FOR
OBVIOUSNESS BASED UPON BAKSHI ET AL., U.S. PATENT NO. 6,836,785 (HEREINAFTER
BAKSHI) IN VIEW OF DUPONT, U.S. PATENT NO. 6,842,800**

On pages 5-11 of the First Office Action, the Examiner concluded that one having ordinary skill in the art would have been realistically impelled to modify Bakshi in view of Dupont to arrive at the claimed invention. This rejection is respectfully traversed.

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness."¹ The legal conclusion of obviousness is based on underlying findings of fact including the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the pertinent arts.² "Secondary considerations such as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented."³ Therefore, to properly make a finding of obviousness, a comparison between the applied prior art and the claims at issue must be made to ascertain the differences between what is being claimed and the teachings of the applied prior art. Moreover, before making a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed.⁴ This burden has not been met.

¹ *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)).

² *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007).

³ *Id.* (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966)).

⁴ See *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994); see also, *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see *Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

Claim 1

At the outset, Applicants note that the Examiner has mischaracterized the teachings of Bakshi. For example, claim 1 recites monitoring data flowing through buffers in a communication system. However, the Examiner's cited passage refers to a single buffer and not a plurality of buffers. Also, the Examiner asserted that Bakshi teachings "computing an optimal buffer size based upon a specification of a required percentage." This assertion, however, is not correct. In this regard, Applicants note that the claimed invention must be considered as a whole. However, by parsing the phrase "a required percentage" from "a required percentage of times a buffer must be able to accommodate data of a particular size," the Examiner is misconstruing the term "required percentage." Moreover, the teachings of Bakshi do not even teach a "required percentage." The percentage referred to in Bakshi is not "required." Instead, the percentage is just a number that alters the capacity of the buffer 302.

Regarding the claimed "required percentage of times a buffer must be able to accommodate data of a particular size," the Examiner identified column 3, lines 24-34 of Dupont. This passage, however, does not teach what the Examiner purports this passage to teach. Instead, this passage teaches that a buffer memory allocator 80 uses packet size information to determine how many of a number of buffer units of each type to allocate. Entirely absent from the teachings of Dupont is the notion of computing an optimal buffer size. Instead, Dupont acts by changing the number of buffers of a particular type.

The question of obviousness does not resolve on whether or not the Examiner can identify within the teachings of the applied prior art the individual elements of the claimed

1 invention. Instead, the question of obviousness resolves on what common sense modifications
2 the applied prior art suggests to one having ordinary skill in the art at the time of the invention.
3 Moreover, the suggested modifications must also result in a reasonable expectation of a
4 predictable result.

5
6 The Examiner's proposed benefit for the modification is "to efficiently allocate buffers
7 for the storage of variable-sized data packets." The Examiner's proposed benefit, however,
8 completely ignores the teachings of Bakshi. Based upon the teachings of Bakshi, whether or not
9 data is efficiently allocated within the buffer 302 is not important. Bakshi varies the size of the
10 buffer to change the delay time of requests waiting in the queue (see column 4, lines 35-44). By
11 decreasing the buffer size, less requests are queued, which reduces the delay time.

12
13 The Examiner's proposed benefit also ignores that the teachings that Bakshi teaches a
14 single buffer. As such, Dupont's methodology for allocating buffers is not applicable to Bakshi.
15 Therefore, for the reasons described above, Applicants' position is that one having ordinary skill
16 in the art would not have recognized that the claimed invention, as recited in claims 1 and 14 are
17 obviousness in view of the combination of Bakshi and Dupont. Applicants, therefore,
18 respectfully solicit withdrawal of the imposed rejection of claims 1-3 and 14-16 under 35 U.S.C.
19 § 103 for obviousness based upon Bakshi in view of Dupont.

20
21 The Examiner's other rejections are presented to claims no longer being presented and,
22 thus, are moot.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction. (emphasis added)

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: June 23, 2008

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320